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10/527,222	12/21/2005	Hansjorg Eibl	HUBR-1279	3227
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FULBRIGHT & JAWORSKI, LLP			EXAMINER	
666 FIFTH AVE			KISHORE, GOLLAMUDI S	
NEW YORK, NY 10103-3198			ART UNIT	PAPER NUMBER
			1612	
			MAIL DATE	DELIVERY MODE
			01/04/2010	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/527,222

**Applicant(s)**

EIBL ET AL.

**Examiner**

GOLLAMUDI S. KISHORE

**Art Unit**

1612

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 September 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 29-48 is/are pending in the application.
- 4a) Of the above claim(s) 39-48 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 29-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/22)
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date 6-9-09; 3-10-05

### **DETAILED ACTION**

1. Newly submitted claims 39-48 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the originally presented and examined claims were composition claims. Instant claims 39-48 are directed to a process of controlled release which were not examined before.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 39-48 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 29-38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear as to what the liposome release as recited in claim 29. The dependent claim 36 recites "further comprising an active compound or a labeling substance" implying that the liposomes in claim 29 are empty. If they are empty, what is there to be released? Furthermore, claim 29 recites "more than 15 to 70 % by weight".

This terminology is confusing since it could mean that the amount could be 15.1 to 70 % and it could even mean that the amount is more than the range recited.

According to claim 29 the liposome has both phosphatidylcholine and phosphatidyl-oligoglycerol. What is being conveyed by the dependent claim 38 which recites "liposome consists essentially of said at least one phosphatidylcholine? These liposomes have only phosphatidylcholine? Applicant has not addressed this issue which was raised before.

4. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 34 recites the broad recitation ether lysolecithin, and the claim also recites hexadecyl phosphocholine which is the narrower statement of the range/limitation. Applicant has not addressed this issue which was raised before.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 29-31, 33, 35-38 are rejected under 35 U.S.C. 102(b) as being anticipated by DE 196 22 224 of record.

DE discloses liposomes containing liposomes containing dipalmitoylphosphatidylcholine (DPPC) and dipalmitoyl phosphatidyloligoglycerols in an amount of approximately 1-50 mol %. Cholesterol is optional (0014, 0018, 0022, Examples of English translation).

Applicant's arguments have been fully considered, but are not persuasive. Applicant argues that the newly presented claims are directed to a process for controlled release of liposome contents from a thermo labile liposome and thus the 102 (b) rejection based on DE 196 22 224 which does not describe such a process should be withdrawn. This argument is not persuasive since the rejected claims are composition claims and not process claims.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 29-33 and 35-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over DE 196 22 224 or Maruyama et al (International Journal of Pharmacology, 1994) of record.

DE discloses liposomes containing liposomes containing dipalmitoylphosphatidylcholine (DPPC) and dipalmitoyl phosphatidyloligoglycerols in an amount of approximately 5 to 15 %. Cholesterol is optional (0014, 0018, 0022, Examples of English translation).

Maruyama discloses liposomes containing phosphatidylcholine (DSPC), phosphatidyloligoglycerol (DPP-PG) and a labeling substance (Table 1 on page 104).

What is lacking in DE and Maruyama is the teaching of instant amounts of phosphatidyloligoglycerol. However, in the absence of showing the criticality, it is deemed obvious to one of ordinary skill in the art to vary the amounts of this compound to obtain the best possible results.

Applicant's arguments have been fully considered, but are not found to be persuasive. Applicant argues that the presently claimed invention relates to liposomes containing more than 15 to 70 wt % of phosphatidyloligoglycerol and a phosphatidylcholine with a main transition temperature in the range from 0 to 80 degrees which have been found to be surprisingly stable in solution and in contrast thereto aggregates which contain phosphatidylmonoglycerol sediment and do not form

any liposomes in a solution. According to applicant, a rapid release of the active agent is achieved by a change in temperature due to a high content of phosphatidyl-oligoglycerol. These arguments are not persuasive. First of all, the presumed rapid release is with a specific formulation containing DPPG2 and specific phosphatidylcholines in specific amounts whereas the claims are directed to phosphatidyloligoglycerol with 70% as the upper limit for the oligoglycerol compound. The results thus are not commensurate with the scope of the claims.

9. Claims 33-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over DE 196 22 224 or Maruyama et al (international Journal of Pharmacology, 1994) of record as set forth above, further in view of Aneja (6,284,267).

The teachings of DE and Maruyama have been discussed above. What is lacking in these references is the inclusion of an alkyl phosphocholine such as hexadecyl phosphocholine.

Aneja while disclosing liposome formulations containing active agents teaches that hexadecyl phosphocholine is an anti-neoplastic agent (Table 2 and Table 3 A on col. 27).

It would have been obvious to one of ordinary skill in the art to use hexadecyl phosphocholine in JP, DE and Maruyama if the intended purpose is to deliver an anti-neoplastic agent with a reasonable expectation of success since Aneja teaches that this compound is an anti-neoplastic agent and could be used in liposomes.

10. Claims 29-33 and 35-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 99/52505 in view of DE 196 22 224 or Maruyama (International Journal of Pharmaceutics, 1994).

WO discloses liposomes containing imaging agent. The liposomes are made of phosphatidylcholine (DSPC and DPPC) and dipalmitoyl phosphatidylglycerol (DPPG). DSPC: DPPC: DPPG are taught in a ratio of 28.5/66.5/5 (example 2 and 20). WO does not teach the use of phosphatidyloligoglycerol.

DE discloses phosphatidyloligoglycerols and liposomes made of these oligoglycerols. DE further teaches the oligoglycerols increase the circulation time of the liposomes (0025 of English Translation). DE teaches about 12% dipalmitoyl phosphatidyloligoglycerols in example 2.

Maruyama discloses liposomes containing phosphatidylcholine (DSPC), phosphatidyloligoglycerol (DPP-PG) in the instant amount, and a labeling substance (Table 1 on page 104). Maruyama further teaches that the oligoglycerols prolong the liposome circulation in vivo (abstract).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of WO and DE or Maruyama and substitute the prior art's dipalmitoyl phosphatidylglycerol with the instant dipalmitoyl phosphatidyloligoglycerols. One would have been motivated to do so with a reasonable expectation of success since DE and Maruyama teach that the presence of this compound in liposomes increases the circulation time of the liposomes.

Applicant provides no specific arguments regarding this rejection. The rejection therefore, is maintained.

11. Claims 29-33 and 35-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 05 194 92 in view of DE 196 22 224 or Maruyama cited above by themselves or in combination.

JP teaches that liposomes made of dipalmitoyl phosphatidylcholine and a negatively charged 1, 2 diacyl glycerophosphatides in weight ratios of 20: 1 to 8:2. According to JP the DPPC and the negatively charged lipid in a specific proportion provides controlled release and temperature sensitivity (English Abstract and claims 1-2).

JP however, does not teach that the negatively charged lipid to be phosphatidyloligoglycerol.

Maruyama discloses liposomes containing phosphatidylcholine (DSPC), phosphatidyloligoglycerol (DPP-PG) in the instant amount, and a labeling substance (Table 1 on page 104). Maruyama further teaches that the oligoglycerols prolong the liposome circulation in vivo (abstract).

DE discloses liposomes containing liposomes containing dipalmitoylphosphatidylcholine (DPPC) and dipalmitoyl phosphatidyloligoglycerols in an amount of approximately 12 % (example 2). Cholesterol is optional (0022 of English translation).

It would have been obvious to use the negatively charged oligoglycerols of DE in the thermo sensitive liposomes containing negatively charged phosphatidylglycerol of

JP with the expectation of obtaining similar results since DE teaches that these compounds can be used to make liposomes in combination with saturated lipids such as DPPC and Maruyama teaches that the circulation times of the liposomes are increased with the incorporation of the oligoglycerols. Although JP, Maruyama and DE do not teach the use of both saturated lipids, DPPC and DSPC, since these are known to be used in the formation of liposomes as evident from the references, it would have been obvious to one of ordinary skill in the art to use them together and vary their amounts with a reasonable expectation of success.

Applicant provides no specific arguments regarding this rejection. The rejection therefore, is maintained.

12. Claims 33-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 05 194 92 in view of DE 196 22 224 or Maruyama cited above by themselves or in combination as set forth above, further in view of Aneja (6,284,267).

The teachings of JP, DE and Maruyama have been discussed above. What is lacking in these references is the inclusion of an alkyl phosphocholine such as hexadecyl phosphocholine.

Aneja while disclosing liposome formulations containing active agents teaches that hexadecyl phosphocholine is an anti-neoplastic agent (Table 2 and Table 3 A on col. 27).

It would have been obvious to one of ordinary skill in the art to use hexadecyl phosphocholine in JP, DE and Maruyama if the intended purpose is to deliver an anti-

neoplastic agent with a reasonable expectation of success since Aneja teaches that this compound is an anti-neoplastic agent and could be used in liposomes.

Applicant provides no specific arguments regarding this rejection. The rejection therefore, is maintained.

### ***Double Patenting***

13. Claims 29-33 and 35-38 are provisionally rejected on the ground of nonstatutory obviousness- type double patenting as being unpatentable over claims 1-4 and 6 of copending Application No. 10/468,116. Although the conflicting claims are not identical, they are not patentably distinct from each other because both are drawn to same thermo labile liposomes containing the same components. Instant claims differ from the claims in the copending application in that the amounts of the phosphatidyloliglycerol in the copending application are in the range of 2-15 % whereas instant amounts are 15 to 70 % In addition, instant claims recite the limitation "comprising. Since phospholipids are known to form bilayer liposomes with or without the addition of any other component it would have been obvious to one of ordinary skill in the art to add additional components or vary their amounts with a reasonable expectation of forming liposomes.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

14. Claims 29-33 and 35-38 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 11-48 of US 6,413,543.

Although the conflicting claims are not identical, they are not patentably distinct from each other because both are drawn to same thermo labile liposomes containing the same components. Instant claims differ from the claims in the US '543 in that the amounts of the phosphatidyloligoglycerol is in the range of 1-50 % whereas instant amounts are 15 to 70 %; it would have been obvious to one of ordinary skill in the art to vary their amounts with a reasonable expectation of forming liposomes. The instant claims also are rejected over the method of making the liposomes, since a restriction has not been made. Thus, one would necessarily have possession of the product, i.e. liposome by following the method of making the liposomes.

15. Claims 33-34 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 and 6 of copending Application No. 10/468,116 in view of Aneja (6,284,267). Although the conflicting claims are not identical, they are not patentably distinct from each other because both are drawn to same thermo labile liposomes containing the same components. Instant claims differ from the claims in the copending application in that the amounts of the phosphatidyloligoglycerol in the copending application are in the range of 2-15 % whereas instant amounts are 15 to 70 % In addition, instant claims recite the limitation "comprising. Since phospholipids are known to form bilayer liposomes with or without the addition of any other component it would have been obvious to one of ordinary skill in the art to add additional components or vary their

amounts with a reasonable expectation of forming liposomes. Although instant claims do not recite alkyl phosphocholines such as hexadecyl phosphocholine, it would have been obvious to one of ordinary skill in the art to use hexadecyl phosphocholine if the intended purpose is to deliver an anti-neoplastic agent with a reasonable expectation of success since Aneja teaches that this compound is an anti-neoplastic agent and could be used in liposomes.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

8. 16. Claims 33-34 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 11-48 of US 6,413,543 in combination with Aneja (6,284,267). Although the conflicting claims are not identical, they are not patentably distinct from each other because both are drawn to same thermo labile liposomes containing the same components. Instant claims differ from the claims in the US '543 in that the amounts of the phosphatidyloligoglycerol is in the range of 1-50 % whereas instant amounts are 15 to 70 %; it would have been obvious to one of ordinary skill in the art to vary their amounts with a reasonable expectation of forming liposomes. The instant claims also are rejected over the method of making the liposomes, since a restriction has not been made. Thus, one would necessarily have possession of the product, i.e. liposome by following the method of making the liposomes. Although instant claims do not recite alkyl phosphocholines such as hexadecyl phosphocholine, it would have been obvious to one of ordinary skill in the art

to use hexadecyl phosphocholine if the intended purpose is to deliver an anti-neoplastic agent with a reasonable expectation of success since Aneja teaches that this compound is an anti-neoplastic agent and could be used in liposomes.

Applicant provides no specific arguments regarding the double patenting rejections. Therefore, the rejections are maintained.

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GOLLAMUDI S. KISHORE whose telephone number is (571)272-0598. The examiner can normally be reached on 6:30 AM- 4 PM, alternate Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Krass Frederick can be reached on (571) 272-0580. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Gollamudi S Kishore/  
Primary Examiner, Art Unit 1612

GSK